

REMARKS

Claims 1, 22 and 37 are amended. The amendments to the claims are for clarification purposes only and are not intended to narrow the scope of the claims in any way. Claims 1-20, 22-26, 28, 30, 33, 34 and 37 are pending.

Claim 1 is objected to as including an informality. Claim 1 is amended in light of the remarks in the Office Action to more clearly recite the invention. Reconsideration of the objection to claim 1 is respectfully requested.

Claims 1-17, 19-20, 22-25, 28, 30 and 33-34 are rejected under 35 U.S.C. §103 as being obvious over 5,802,468 to Gallant et al. ("Gallant") in view of U.S. Patent 6,216,007 to Harvinis et al. ("Harvinis"). Claims 18 and 26 are rejected under 35 U.S.C. §103 as being obvious over Gallant in view of Harvinis and further in view of U.S. Patent 5,905,957 to Olds ("Olds"). Claim 37 is rejected under 35 U.S.C. §103 as being unpatentable over Gallant in view of U.S. Patent Publication 2003/0148775 to Spriestersbach et al. ("Spriestersbach").

In order to maintain a valid obviousness rejection, the Office Action must show: 1) that the prior art teaches all of the claimed limitations and 2) that is some reason to modify the prior art to produce the claimed invention, MPEP §2141. Both requirements are missing here.

Rejections based on Gallant in view of Harvinis and Olds

1. A combination of the cited prior art does not show the claimed invention

Among the limitations of independent claim 1, which are neither disclosed nor suggested even in a combination of the cited art are:

each mobile device comprising a module insertable into, removable from and distinct from the mobile device, . .
wherein each module is configured to determine whether a respective mobile device is located inside the at least one subscriber territory.

Similarly, among the limitations of independent claim 33, which are neither disclosed nor suggested even in a combination of the cited art are:

determining, using a module insertable into, removable from, and distinct from the mobile device, whether the first identifier matches the second identifier; and
informing a subscriber of the mobile device that the subscriber is within the subscriber territory when the first identifier matches the second identifier.

As discussed in prior Communications. The invention allows for moving the process for determining whether a mobile station is disposed in a subscriber territory, from the mobile station itself, to a module distinct from the mobile station. The module may perform the determination processing as in claims 1 and 33 or may poll a determination unit that performs processing external from the mobile device as in claim 37.

The Office Action on pages 4-5 agrees that the above limitations are not shown in Gallant and points to Harvinis. However, Harvinis does not disclose a module that can determine whether a respective mobile device is located inside a subscriber territory as is claimed. Harvinis appears to teach a method for calculating a geographical location of a mobile terminal by applying Enhanced Observed Time Difference or GPS location calculation methods. Harvinis does not appear to show that a module can determine whether the location of the mobile device is in inside a subscriber territory.

Moreover, in Harvinis the calculation of the mobile station is carried out by a positioning measurement module ("PMM") within the mobile terminal and a location calculation module on a smart IC card which is separated from the PMM. The PMM includes an algorithm 202 specific to the positioning methods used. Harvinis, col. 4: lines 54-55. Therefore, in Harvinis, even the calculation of the mobile station is partly performed by the mobile station itself so that specially equipped mobile devices are required. In stark contrast, the present invention uses a module, which may be separated from the mobile device, to determine whether the mobile device is located in the subscriber territory. A benefit of the invention is that no special application is required on the part of the mobile device to handle such a service.

Further, even a combination of Gallant and Harvinis does not appear to show a SIM card performing calculations based on an identifier as claimed in independent claim 33. The Office Action, on pages 15-17, indicates that Gallant teaches using identifiers

such as BTS identifiers to determine location information and then points to Harvinis as teaching location determination by a SIM card. However Harvinis does not show any ability of a SIM card to determine location based on identifiers. In fact, Harvinis explicitly teaches that transmittal of BTS identifiers to a mobile station is contrary to its goals because a mobile subscriber can manipulate the received information. Harvinis, Col. 4: lines 30-34. Therefore, even the combination of Gallant with Harvinis does not show the claimed limitations and Harvinis explicitly teaches against the proposed combination. Olds is not cited to show, and does not appear to show, the cited limitations.

2. There is no valid motivation to combine Gallant and Harvinis

In addition, one with ordinary skill in the art would not be motivated to modify Gallant in view of Harvinis as suggested in the Office Action. Page 5 of the Office Action states that the motivation to combine these two references is to achieve a benefit of transmission efficiency and service variety or that the modification is simply a rearranging of parts. One with ordinary skill in the art, given the motivation of providing better transmission efficiency, would not be motivated to move the calculations in Gallant to a SIM card as shown in Harvinis. Transmission efficiency appears to be unrelated to this change. Further, such a modification is also not simply a rearranging of parts as suggested in the Office Action because a more complex and expensive SIM card is used.

Rejections based on Gallant in view of Spriestersbach

Among the limitations of independent claim 37, which are neither disclosed nor suggested even in a combination of the cited art are:

each mobile device comprising a module insertable into,
removable from and distinct from the mobile device. . .
wherein each module is configured to poll a determination
unit external from the mobile device and receive information from
the determination unit regarding whether a respective mobile
device is located inside the at least one subscriber territory.

In claim 37, the SIM module polls a determination unit external to the mobile device to determine whether the mobile device is located in a subscriber territory. The Office Action points to paragraph 100 of Spriesterbach as showing this functionality. However, this section of Spriesterbach indicates that an application external to the mobile unit can determine the location of the mobile unit. Yet, there is no indication that this location is then sent back to the mobile unit for its use. In fact, the purpose of this calculation is to optimize selected customer lists by providing lists sorted by distance not to enable a mobile device to know its location. See, paragraph 99.

In paragraphs 97-100 of Spriesterbach, an application server 804 sends the current user location to GIS application 808. Based on the user location, the GIS application 808 is able to select only those customers that are within a given radius of the user's location

and returns the selected records to the application. Spriesterbach does not mention at all whether the user is located inside the subscriber territory associated with the mobile device. Spriesterbach only returns a list of customers that are nearby the user location.

The above distinction was expressed in the claim language prior to amendment "wherein each module is configured to poll a determination unit external from the mobile device to determine whether a respective mobile device is located inside the at least one subscriber territory". However, to make this distinction even clearer, this Communication replaces "to determine" with --and receive information from the determination unit regarding--. Spriestersbach does not teach this recitation.

Therefore, it is asserted that independent claims 1, 33 and 37 are patentable over the cited prior art. Claims 2-20, 22-26, 28, 30 and 34 include the above referenced limitations of independent claims 1 and 33 respectively, and include additional limitations which, when combined with the limitations of claims 1 and 33 are also neither shown nor suggested in the art of record. It is asserted that these claims are patentable as well.

Reconsideration of the rejections of claims 1-20, 22-26, 28, 30, 33, 34 and 37 under 35 U.S.C. §103 is respectfully requested in light of the remarks above.

Respectfully submitted,



Steven Rubin
Reg. No. 43,063
Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
1000 Woodbury Road, Suite 405
Woodbury, New York 117973
Telephone: 516-228-8484
Facsimile: 516-228-8516